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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,798	12/29/2005	Toru Maeda	070456-0098	8704
20277 7590 03/19/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
HARRIS, GARY D				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/562,798

**Applicant(s)**

MAEDA ET AL.

**Examiner**

GARY D. HARRIS

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9, 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 4, 6, 9 & 12 rejected under 35 U.S.C. 102(b) as being anticipated by Watson et al. ("Synthesis of a novel magnetic photocatalyst by direct deposition of nanosized TiO<sub>2</sub> crystals onto a magnetic core", *Journal of Photochemistry and Photobiology A: Chemistry*, Vol. 148, 303-313, 2005.5.31).**

As to Claim 1, Watson discloses a soft magnetic material (iron oxide core using sol-gel process similar to applicants) (Page 304, (Col. 1, Paragraph 3) with a plurality of composite magnetic particles (Page 310, column 2 coated particles). Each composite magnetic particle has a metal magnetic particle of iron (Fe<sub>3</sub>O<sub>4</sub> as the seed particle) (Page 310, column 1). On the iron, a lower film surrounding a surface of said metal magnetic particle is formed of an oxide of a nonferrous metal (Page 310, Col. 2, the lower film is (SiO<sub>2</sub>). The lower film (SiO<sub>2</sub>) satisfies a composition range that oxygen is less than oxygen of a stoichiometric composition of a compound (Fe<sub>2</sub>O<sub>3</sub>) and constitutes an element and oxygen as the lower film (SiO<sub>2</sub>) (Page 305, Col. 1). This is because both applicant and Watson are using the same structure (Fe<sub>2</sub>O<sub>3</sub>/SiO<sub>2</sub>/TiO<sub>2</sub>)

and similar process (sol-gel) and would therefore possess the same compositional and stoichiometric range of oxygen (see MPEP 2112). The insulating upper film surrounds the lower film and includes oxygen ( $\text{TiO}_2$ ) (Page 308, Table 4). The nonferrous metals used include silicon and titanium (Page 306, Col. 2).

The absolute value of heat generated when a primary compound is produced ( $\text{Fe}_2\text{O}_3$ ) by a reaction between oxygen and said one of silicon (Si) and titanium (Ti) is greater than an absolute value of heat generated when a primary compound is produced by a reaction between iron and oxygen. As disclosed by applicant, the heat generated is based on material. Since the materials ( $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{TiO}_2$ ) and process (sol-gel) taught in the reference are the same as those disclosed, the structure would inherently have equivalent absolute values of heats of formation. See MPEP 2112.

As to Claim 4, Watson discloses the soft magnetic material with an upper film made from a titanium compound (Page 304, Col. 1).

As to Claim 6, Watson is silent to the dust core fabricated using the material in claim one. However, the material would inherently function as a dust core in an equivalent manner as the material claimed. Further, the limitation(s) "a dust core fabricated", the Examiner notes that limitation is a preamble limitation which does not set forth any structure, but merely state(s) the purpose or intended use of the invention. As stated in the MPEP, "if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the

purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, *then the preamble is not considered a limitation and is of no significance to claim construction.* (See MPEP 2111.02). In the instant case, a dust core would be an intended use preamble limitation.

As to Claim 9, Watson discloses a soft magnetic material (iron oxide core using sol-gel process similar to applicants) (Page 304, (Col. 1, Paragraph 3) with a plurality of composite magnetic particles (Page 310, column 2 coated particles). Each magnetic particle has a metal magnetic particle of iron ( $\text{Fe}_3\text{O}_4$  as the seed particle) (Page 310, column 1). On the iron, a lower film surrounding a surface of said metal magnetic particle and being formed of an oxide of a nonferrous metal (Page 310, Col. 2, the lower film is  $\text{SiO}_2$ ). The lower film ( $\text{SiO}_2$ ) satisfies a composition range where oxygen is less than oxygen of a stoichiometric composition of a compound ( $\text{Fe}_2\text{O}_3$ ) and constitute an element and oxygen as the lower film ( $\text{SiO}_2$ ) (Page 305, Col. 1). This is because both applicant and Watson are using the same structure ( $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{TiO}_2$ ) and similar process (sol-gel) and would possess the same compositional and stoichiometric ranges of oxygen (see MPEP 2112). The insulating upper film surrounds the lower film and includes oxygen ( $\text{TiO}_2$ ) (Page 308, Table 4). The nonferrous metals used include silicon and titanium (Page 306, Col. 2). With regard to the diffusion coefficient with respect to the oxygen included in said upper film that is smaller than the diffusion coefficient of iron, since the materials ( $\text{Fe}_2\text{O}_3/\text{SiO}_2/\text{TiO}_2$ ) and process (sol-gel) taught in the reference are the same as those disclosed, the structure would inherently have

similar diffusion coefficients. See MPEP 2112.

As to Claim 12, Watson discloses the soft magnetic where the upper film includes a silicon compound, and a titanium compound. (See Page 304, Column 2)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 3, 5, 11 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. ("Synthesis of a novel magnetic photocatalyst by direct deposition of nanosized TiO<sub>2</sub> crystals onto a magnetic core", Journal of Photochemistry and Photobiology A: Chemistry, Vol. 148, 303-313, 2005.5.31)**

As to Claim 3, 5, 11 & 13, Watson discloses the soft magnetic material has a controllable outer layer thickness with the ultimate aim to tailor desired characteristics such as tailor the photocatalytic performance (Page 308) into the final coated particle and uniformity of coating (Page 303, Col. 2).

Watson is silent to the lower film has an average thickness of not less than 50 nm and not more than 1 micron.

However, it would have been obvious to one skilled in the art to change the thickness of the lower film in order to tailor the photocatalytic performance (Page 308) into the final product (Page 303, Column 2).

One would have been motivated to adjust the thickness of the lower film in order to allow for uniformity of the coated particle  $\text{SiO}_2$  layer to allow adhesion of the  $\text{TiO}_2$  layer.

One of ordinary skill would have adjusted the thickness based on magnetic interaction between the particles as the thickness of the coatings increase the magnetic interaction will decrease between particles.

**Claim 7, 14 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. ("Synthesis of a novel magnetic photocatalyst by direct deposition of nanosized TiO<sub>2</sub> crystals onto a magnetic core", Journal of Photochemistry and Photobiology A: Chemistry, Vol. 148, 303-313, 2005.5.31) and further in view of Ueta et al. 2004/0126609.**

As to Claim 7, 14 & 15, Watson is silent with regard to a dust core having an organic matter disposed between said plurality of composite magnetic particles to join said plurality of composite magnetic particles together and including at least one selected from the group consisting of a polyethylene resin, a silicone resin, a polyamide resin, a polyimide resin, a polyamide imide resin, an epoxy resin, a phenolic resin, an acrylic resin and a polytetrafluoroethylene.

Ueta et al. 2004/0126609 discloses a metal powder for powder for providing magnetic cores (similar to applicant see abstract) using polymeric resistant films and organic substances such as epoxy resin, phenolic resin, silicone resin, amide resin, (Paragraph 108) and discloses the use of polyamide (see table 1) (Paragraph 134-135). Ueta '609 teaches molding the particles together (Paragraph 0119 & 0120) and are used in various applications because of there compressibility of the coated powder onto the magnetic core (Paragraph 0111). Since a dust core is made by mixing powdered magnetic material with an insulative binder the magnetic core is a dust core.



It would have been obvious to one skilled in the art to use a dust core (magnetic core), having an organic matter disposed between said pluralities of composite magnetic particles of Watson in order to provide a method of molding the particles together as taught in Ueta. One would have been motivated to add the Ueta polymeric and silicone materials in Watson in order to provide compressibility and allow molding of the magnetic material. One of ordinary skill would have recognized that a magnetic powder with a polymer or silicone would produce a moldable material and be molded into a dust core.

### ***Response to Arguments***

Applicant's arguments filed on 11/23/2009 with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.